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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,198	04/04/2005	Yoko Matsuzawa	040894-7204	9611
9629	7590	02/08/2006	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			AUDET, MAURY A	
			ART UNIT	PAPER NUMBER
			1654	
DATE MAILED: 02/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/530,198

Applicant(s)

MATSUZAWA ET AL.

Examiner

Maury Audet

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-13 is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 8 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04/04/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed 04/04/2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Namely, Applicant has not included a copy of the non-patent literature document by Bergeron et al. (J. Am. Chem. Soc., 1995, Vol. 117, pgs. 6658-6665). It has been placed in the application file, but the information referred to therein has not been considered.

Claim Objections

Claim 8 is objected to because of the following informalities: In lines 1-3, the recitation of the phrase "a fine particle of a hydrophilic core substance are encapsulated inside the spherical body of the compound represented by formula (1)" renders the claim somewhat confusing. As noted in claim 1 and i.e. specification page 1, lines 11-12, the fine particle is necessarily the compound of formula (1) (although the substance to be encapsulated could also be a fine particle). To clarify the context of the subject matter, it is suggested the claim be amended to delete the language above and replace with --a hydrophilic core substance is encapsulated inside the fine spherical particle of the compound represented by formula (1)--. Appropriate correction or clarification is required.

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Likewise, claim 10 is objected to because of the following informalities: In lines 1-2, the recitation of the phrase “a fine particle of a hydrophilic core substance” renders the claim somewhat confusing. In line with the discussion above, it is suggested that the claim be amended to delete the language “a fine particle of”. Appropriate correction or clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Hotta et al. (US 6,489,265 B1).

Hotta et al. teach a fine spherical particle having uniform molecular orientation, which comprises a compound represented by formula (1), wherein R represents a hydrogen atom or an alkyl group having 1 to 5 carbon atoms; n is an integer of 8 to 20; and m is an integer of 1 to 3; evenly oriented in a radial pattern from the center; with a diameter from 0.01 to 100 micrometers (see col. 12, lines 36-41 and col. 13, lines 18-21 (teaching that a prepared organic low-molecular-weight material may consist of two or more compounds of compound A); Table 1 Compounds A #'s 1-10; Synthesis Ex.'s 1 and 2 of Compounds A (e.g. formula (1) species); col. 22, lines 36-41 and lines 61-64 and col. 23, lines 17-22 (teaching that the organic material may

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be fine particles (and as noted before, which consist of 2 or more Compounds A alone), which are spherical); and col. 23, lines 13-16 (teaching the particles are 20 or less micrometers in size)).

Therefore, the reference is deemed to anticipate the instant claims above.

Allowable Subject Matter

Claims 4-13, as drawn to a process for producing the fine spherical particle comprising the compound of formula (1) comprising immersing a substrate having hydrophilicity in an aqueous solution of a salt of the compound of formula (1); a spherical microcapsule comprising a hydrophilic core substance encapsulated inside the fine spherical particle of formula (1), and process for producing the latter, respectively, are not reasonably taught or suggested by the prior art of record. Thus, Applicant's method of preparing either of the above, whereby the compound(s) become insoluble under a weak acid thereby precipitating onto the hydrophilicity bearing/treated substrate (see Applicant's specification page 9, lines 10-15), was not reasonably taught or suggested by the prior art of record.

The closest prior art of record appears to be Hotta et al. Hotta et al. teach the use of a salt (sodium hydroxide) to prepare the fine spherical particle comprising the compound of formula (1), but does not expressly or reasonably provide motivation for a method of producing the above using a substrate having hydrophilicity, wherein the particle is precipitates onto the substrate, followed by extraction therefrom (Applicant's claims 4-7).

In addition, the prior art of record was found to teach general methods of making encapsulated microcapsules (as also discussed by Applicant, on specification page 2, lines 3-20). However, the prior art of record art does not reasonably teach or suggest Applicant's unexpected

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result of producing self-assembling microcapsules comprising fine spherical particles encapsulating hydrophilic core substances (Applicant's claims 8-13, and as described in specification page 3, lines 17-24).

Conclusion

Claims 4-13 are allowed.

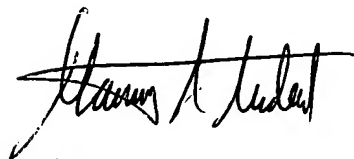
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 571-272-0960. The examiner can normally be reached from 7:00 AM – 5:30 PM, off Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached at 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

MA 02/01/05



MAURY AUDET

PATENT EXAMINER

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